

**THE OFFICE ACTION**

In the Office Action mailed June 29, 2005, claims 1-15 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,911,406.

Claims 1-15 also stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of co-pending Application No. 10/736404.

Claims 1-4, 6, 7, 9, 10 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,130,174 issued to Hawley et al. (Hawley) in view of U.S. Application No. 2005/0112314 filed by Hamilton et al. (Hamilton).

Claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley and Hamilton as applied to claim 1, and further in view of U.S. Patent No. 5,874,371 issued to Owen.

Claim 8 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley and Hamilton as applied to claim 1, and further in view of U.S. Application No. 2003/0036323 filed by Allabadi.

Claims 11-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hawley in view of Hamilton, and U.S. Application No. 2002/0094404 filed by Schottenfeld.

**REMARKS****Double Patenting**

Accompanying this response is a Terminal Disclaimer in compliance with 37 CFR § 1.321(c) to overcome the double patenting rejection of Claims 1 through 15. The conflicting patent and co-pending application, U.S. Patent No. 6,911,406 and U.S. Application Serial No. 10/736404, and the present application, serial number 10/736405, are all assigned to the same entity and are commonly owned.

In view of the filing of the Terminal Disclaimer and the common ownership of the cited patent, co-pending application and the present application, the withdrawal of the rejection of Claims 1 through 15 is respectfully requested.

**Claims are Patentable over Hawley in View of Hamilton**

With reference to the rejection of claims 1-4, 6, 7, 9, 10 and 15, Hamilton is

cited in the Office Action mailed June 29, 2005 as disclosing a high bond strength, repositionable adherent sheet which material can be used in shelves. Applicant respectfully points out, however, that the adherent sheet material disclosed by Hamilton is not repositionable in the same sense as the embossed film as set forth in claim 1 of the present application. As described in paragraphs 35 and 36 of Hamilton, the term "selectively-activatable" [sic] is used to refer to materials which exhibit substantially non-adherent properties when brought into contact with target surfaces until some action is taken by any user to activate the material's adhesive properties. As described in paragraph 36, the selective activation allows the user to properly position the sheet material upon a target surface before activation and adhesion are accomplished. As further described in paragraph 36, the selective activation process can be temporary in the sense that minimal contact occurs between adhered non-raised regions and a contact surface for evaluation of the sheet materials position without significant loss of adhesive capability if the sheet is removed for repositioning. Hamilton does not teach or suggest that the sheet is removable in any other sense beyond temporary positioning for evaluation. In other words, Hamilton does not teach that the adherent sheet may be repositioned after final application.

It is additionally stated in the Office Action that the sheet material of Hamilton can be embossed on the front surface with reference to paragraphs 30, 72 and 73. However, Hamilton seems to only teach or disclose embossing of the flexible film sheet (20) for the purpose of producing non-adhesive protrusions (26). For example, with reference to Figure 1 and paragraph 33, Hamilton discloses that the adherent sheet material includes a piece of flexible foam sheet (20) having an operational front face (22) and three-dimensional protrusions (26) extending outwardly from the front face (22), and adhesive non-raised regions (28) located between the protrusions (26). The flexible film sheet described by Hamilton does not correspond to the embossed vinyl film as recited in claim 1 of the present application.

As shown in Figure 3 of Hamilton, the protrusions embossed into the flexible film sheet only serve to prevent premature contact between the adhesive region (12) and the target surface (50) to which the adhesive sheet is being applied. With reference to Figure 4 of Hamilton, and paragraphs 59 through 60, it is the substrate

(40) which is laminated by an adhesive to the flexible film (20) of Hamilton that corresponds more appropriately to the embossed vinyl film of the present application.

Some confusion may arise from the fact that the present application describes the substrate as the non-slip layer (14) to which the embossed film (12) is adhered (paragraph 16). However, Hamilton describes the substrate (40) as the outermost layer which may contain a decorative pattern such as is found in wall coverings (paragraph 61). Therefore, it is the substrate (40) of Hamilton which corresponds more appropriately to the embossed film (12) of the present application. And further, Hamilton does not teach or disclose any embossing process for the substrate 40. Rather, with reference to Figures 9–11 and paragraphs 72–75, Hamilton describes a method or procedure of embossing the film sheet (20). The film sheet (20), however, does not correspond to the embossed film of the present application. Rather, the film sheet (20) is the backing layer, the protrusions of which contact the contact surface (50) as described in paragraph 45 and shown in Figures 3 and 4.

Paragraph 74 describes the film sheet being introduced into a nip region where it is permanently and mechanically deformed by matching sets of embossing drums. A substrate (40), however, as described in paragraph 76, is bonded to the film sheet while the film sheet is still integrally connected with the female embossing drum (64). However, this is after the film sheet has passed through the nip region between the matching set of embossing drums, and the embossing has occurred before application of the substrate. Hamilton does not disclose any embossing of the substrate 40 which, as mentioned above, corresponds more appropriately to the embossed vinyl film of the present application.

Applicant respectfully submits for the foregoing reasons that Hamilton cannot be properly combined with Hawley to arrive at the embossed, removable, non-slip, non-adhesive covering as recited in claim 1 of the present application. Further, there is no motivation to combine Hamilton with Hawley since Hamilton teaches an adherent sheet as opposed to a non-adhesive covering, and Hamilton does not add any teachings to Hawley that are relevant to the limitations recited in claim 1 of the present application. Further, Hawley does not teach or suggest an embossed top surface or covering as recited in independent claim 1, but to the contrary, teaches

away from an embossed surface by describing only a smooth top layer in col. 3, lines 5-12, and by including a limitation for a generally flat vinyl plastic sheet in each of independent claims 1 and 5.

For the above-described reasons, Applicant submits that independent claims 1 and 15 are patentably distinct over the references and, therefore, are in condition for allowance, as are claims 2-10 depending from claim 1.

**Claims are Patentable over Hawley in View of Hamilton and Owen**

With reference to claim 5, the Office Action asserts that Hawley and Hamilton disclose the claimed invention except for the teachings that the scrim is a non-woven scrim. However, for the reasons set forth with respect to independent claim 1, from which claim 5 depends, Applicant respectfully submits that dependent claim 5 is in condition for allowance.

**Claims are Patentable over Hawley in View of Hamilton and Aliabadi**

With reference to claim 8, the Office Action asserts that Hawley and Hamilton disclose the claimed invention except for the teachings that the scrim is a polyester scrim. The Office Action further states that Aliabadi discloses a layer of polyester mesh fabric between layers of polyvinyl chloride. It should be noted that, although Aliabadi describes the polyester mesh fabric as being between layers of polyvinyl chloride in paragraph 23, Aliabadi's polyester mesh fabric is unlike the woven polyester scrim of the present application which is coated with a non-slip polyvinyl chloride resin as recited in dependent claim 8, rather than being placed between layers of polyvinyl chloride. However, for the reasons set forth with respect to independent claim 1, from which claim 8 depends, Applicant respectfully submits that dependent claim 8 is in condition for allowance.

**Claims are Patentable over Hawley in View of Hamilton and Schottenfeld**

Independent claim 11 and claims 12-14 depending therefrom are rejected for reasons similar to those stated in the Office Action for rejecting independent claim 1 but, additionally, the Office Action cites Schottenfeld as disclosing a release layer added to the liner. However, for the same reasons as set forth with respect to claim 1 above, namely, with respect to the remaining three limitations of independent claim 11 which are similar to those recited in claim 1, independent claim 11, and claims 12-14 depending therefrom are patentably distinct over the cited references.

**CONCLUSION**


For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-15) are now in condition for allowance. Should the Examiner need more information or wish to discuss the present application, Applicant would appreciate the opportunity to assist in moving the case forward to a successful conclusion. In this regard, Thomas Young may be contacted at 216-861-5582.

Respectfully submitted,

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12-29-05

Date

  
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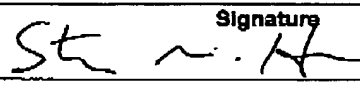
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